

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant/Appellant	: Roger Youman et al.)
Application No.	: 09/313,532 (for reissue of U.S. Patent 5,629,733))
Filed	: May 13, 1999)
For	: ELECTRONIC TELEVISION PROGRAM GUIDE SCHEDULE SYSTEM AND METHOD WITH DISPLAY AND SEARCH OF PROGRAM LISTINGS BY TITLE)
Group Art Unit:	: 2421)
Examiner	: Hunter Lonsberry)
Appeal No.	: 2010-007029)

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**NOTICE OF APPEAL
TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

Dear Sir:

You are hereby notified of an appeal to the United States Court of Appeals for the Federal Circuit from the decision of the Board of Patent Appeals and Interferences rendered on September 8, 2010, a copy of which is attached hereto, as well as any prior decision of the Board on which the September 8, 2010 decision is based, rejecting claims

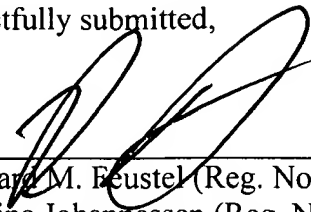
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of the above-identified reissue patent application and refusing a reissue patent for the invention set forth therein.

Respectfully submitted,

Dated: November 3, 2010

By



Richard M. Feustel (Reg. No. 46,698)
Pristine Johannessen (Reg. No. 55,302)
Attorneys for Appellants
ROPES & GRAY LLP
Customer No. 75563
1211 Avenue of the Americas
New York, New York 10036
Telephone: (212) 596-9000
Facsimile: (212) 596-9090



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,532	05/13/1999	ROGER YOUMAN	UV-132 RE	4047
75563 7590 09/08/2010 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER LONSBERRY, HUNTER B	
			ART UNIT 2421	PAPER NUMBER
			MAIL DATE 09/08/2010	DELIVERY MODE PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER YOUMAN and MARNEY MORRIS

Appeal 2010-007029
Application 09/313,532
Patent 5,629,733
Technology Center 2400

Before ALLEN R. MacDONALD, *Vice Chief Administrative Patent Judge*,
JOHN A. JEFFERY, and ROBERT E. NAPPI, *Administrative Patent
Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 24-27, 29-43, and 45-55. Claims 1-23 have been

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

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indicated as containing allowable subject matter. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).² We affirm.

STATEMENT OF THE CASE

Appellants seek to reissue U.S. Patent 5,629,733 which pertains to an electronic television program guide and using a wireless remote control to search program listings by title. *See generally* '733 Patent, 'Abstract; col. 31, l. 52–col. 32, l. 16; Figs. 4, 38F. Patent claim 1 and reissue claim 24 are illustrative with key limitations emphasized:

1. An electronic television programming guide for use in connection with a television receiver for displaying a plurality of television programs from a plurality of program sources on a plurality of user-selectable television channels comprising:

user control means for issuing control commands, including channel-control commands;

data processing means for receiving said control commands and for generating video control commands;

video display generator means adapted to receive video control commands from said data processing means for generating and displaying a visual display of a plurality of television program titles on said television receiver, said plurality of television program titles arranged alphabetically by title; and

selection means for allowing said user to select a title for display on said television receiver by selecting the first n characters of said title, where n is greater than one; said data processing means being responsive to said selection means and adapted to select said plurality of television program titles for display on said television receiver in response to said n characters;

² Appellants waived attendance at an oral hearing scheduled for August 12, 2010. *See* Hearing Waiver Confirmation filed July 12, 2010.

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wherein said video display generator means displays said n characters and said *selection means comprises means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters* and means for assigning one of said alphanumeric characters to each of said n characters.

24. An electronic television programming guide for use in connection with a television receiver for displaying a plurality of television programs from a plurality of sources on a plurality of user-selectable television channels comprising:

a wireless remote control, comprising nonalphanumeric keys, that generates control commands;

a data processor that receives the control commands from the wireless remote control; and

a video display generator connected to the data processor that displays an alphabetically-arranged visual display of a plurality of television program titles on said television receiver,

wherein a user may search for a title to be displayed by selecting n characters with the wireless remote control, where n is greater than one, wherein *each of the n characters may be selected with the wireless remote control from a plurality of displayed alphanumeric characters by changing from a first character to a second character using the nonalphanumeric keys.*

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THE REJECTION

The Examiner rejected claims 24-27, 29-43, and 45-55 under 35 U.S.C. § 251 as improperly recapturing surrendered subject matter. Ans. 3-4.³

CONTENTIONS

The Examiner finds that independent reissue claims 24 and 40 omit the limitation in independent claim 1 of the original '733 patent reciting means for causing each character to cycle forward and backward through plural alphanumeric characters. Ans. 3-7. According to the Examiner, since this limitation was added to claim 1 during prosecution of the original patent responsive to a prior art rejection to render the claim allowable, omitting this limitation via reissue impermissibly recaptures surrendered subject matter under § 251. *Id.*

Appellants argue that while reissue claims 24 and 40 are broader than issued claims 1 and 12 in aspects unrelated to the prior art rejections (i.e., regarding the data processor and video display generator), the reissue claims are narrower than the “surrendered claim” (which is said to be original claim 1 prior to amendment) in aspects related to the prior art rejections. App. Br. 11-17; Reply Br. 12-15. According to Appellants, reissue claims 24 and 40 are narrower because neither “surrendered claim 1” nor issued claims 1 and 12 recite selecting characters from plural displayed characters with a wireless remote control by changing from a first character to a second

³ Throughout this opinion, we refer to (1) the Appeal Brief filed April 1, 2009; (2) the Examiner’s Answer mailed June 23, 2009; and (3) the Reply Brief filed August 24, 2009.

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character using the control's nonalphanumeric keys as recited in reissue claims 24 and 40. App. Br. 14-16; Reply Br. 14-15. Appellants add that since these aspects were overlooked during original prosecution, they materially narrow the reissue claims to avoid recapture. App. Br. 4-5; Reply Br. 15-16. The issues before us, then, are as follows:

ISSUES

Under § 251, has the Examiner erred in rejecting reissue claim 24 by finding that the claim improperly recaptures surrendered subject matter? This main question turns on the following issues:

(1) In what respect is reissue claim 24 broader in scope than claim 1 of the original patent?

This issue turns on whether the limitation calling for selecting characters from plural displayed characters with a wireless remote control by changing from a first character to a second character using the control's nonalphanumeric keys recited in reissue claim 24 is broader than the selection means comprising means for causing each character to cycle forward and backward through plural alphanumeric characters recited in issued claim 1.

(2) If so, does this broadening relate to the subject matter surrendered during prosecution of the original patent?

(3) Was reissue claim 24 materially narrowed so as to be directed to "overlooked aspects" of the invention and avoid recapture?

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FINDINGS OF FACT (FF)

The Parent Application

1. U.S. Patent Application 08/346,603 ("the parent application") was filed November 19, 1994 and included claim 1 directed to an electronic television programming guide (EPG) reproduced below:

1. An electronic television programming guide for use in connection with a television receiver for displaying a plurality of television programs from a plurality of program sources on a plurality of user-selectable television channels comprising:

user control means for issuing control commands, including channel-control commands;

data processing means for receiving said control commands and for generating video control commands;

a video display generator adapted to receive video control commands from said data processing means for generating and displaying a plurality of television program titles on said television receiver, said plurality of television programs displayed alphabetically by title; and

selection means for allowing said user to select a title for display on said television receiver by selecting the first n characters of said title, where n is greater than or equal to one; said data processing means being responsive to said selection means and adapted to select said plurality of television program titles for display on said television receiver in response to said n characters.

Parent Appl'n, at 66.

2. On January 30, 1996, the Examiner rejected claim 1 under 35 U.S.C. § 103 over three prior art references (Young, Vogel, Reed). Non-Final Rej. mailed Jan. 30, 1996, at 2-4.

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3. On March 11, 1996, Appellants filed an amendment that (1) added claims 2-23, and (2) amended claim 1 to, among other things, add the following language: “wherein said video display generator displays said n characters and said selection means comprises means for causing said character displays to cycle forward and backward through a plurality of alphanumeric characters and means for assigning one of said alphanumeric characters to each of said n characters.” Amd’t A filed Mar. 11, 1996, at 2-8.

4. In the remarks accompanying Amendment A, Appellants note the following:

Users are provided with a user control means (e.g., a remote control device) that is used to input a plurality of characters in the title of a program. Because remote control devices generally do not include full alphanumeric keyboards, the characters are selected by cycling through letters and numbers until the desired character is obtained. For example, the channel up/down arrow keys, present on virtually all television, cable decoder box, and VCR remote control devices, may be used to cycle backward and forward through the alphabet and the digits 0-9 in order to select each of the characters.

Remarks Accompanying Amd’t A filed Mar. 11, 1996, at 8-9.

5. In the remarks accompanying Amendment A, Appellants further note the following:

The requirements and constraints for an EPG system are very different from those for a PC-based database search system. For example, the system disclosed in Reed operates using a full keyboard. As such, it is a simple matter to type in the first few letters of an article title. In contrast, in an EPG environment, the user control device is typically a hand-held

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remote control transmitter with only a very limited number of keys. Therefore, in terms of performing searching based on alphanumeric characters, EPGs present a problem not present in nor solved by systems such as that described in Reed.

Applicants solve this problem by using existing keys on the remote control device to input the characters of a program title. . . . For example, as disclosed in applicants' specification, the up/down arrow keys used for changing channels in normal television mode may be used to cycle through the letters A-Z and the numbers 0-9 in order to choose the individual letters in a program title.

Remarks Accompanying Amd't A filed Mar. 11, 1996, at 12.

6. In the remarks accompanying Amendment A, Appellants further note the following:

[A]pplicants submit that the Examiner has used improper hindsight reconstruction to conclude that in view of Reed it would have been obvious to implement title searching in an EPG. In the absence of applicants' disclosure, one of ordinary skill in the art is faced with the dilemma of how to input 36 different characters (A-Z and 0-9) using only a few keys on a remote control device. Applicants therefore submit that the combination of Reed and Young or Vogel is improper.

Furthermore, . . . because Reed does not disclose how to select multiple characters in a title using only a remote control device, one of ordinary skill in the art would still not be possessed of the invention described and claimed by applicants. For example, claim 1 has been amended to recite i) that a plurality of characters in the title are input by the user, and ii) the specific means by which this is done -- providing a user selection means to "cycle forward and backward through a plurality of alphanumeric characters" in order to locate each of the desired characters in the title.

Remarks Accompanying Amd't A filed Mar. 11, 1996, at 13-14 (emphasis in original).

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7. On May 17, 1996, Appellants filed a supplemental amendment that, among other things, amended the last clause of the claim as follows (with bracketing and underlining to indicate deletions and insertions): “said selection means comprises means for causing each of said n characters [displays] to cycle forward and backward through a plurality of alphanumeric characters and means for assigning one of said alphanumeric characters to each of said n characters.” Supp. Amd’t B filed May 17, 1996, at 2.

8. On August 20, 1996, the Examiner mailed a Notice of Allowability that (1) indicated the “communication is responsive to 3/11/96 and 5/17/96 Amendment” [sic]; (2) allowed claims 1-23; and (3) attached the following Reasons for Allowance:

Claims 1-23 are allowable because the prior art fails to disclose or suggest an electronic television program guide comprising a selection means for allowing a user to select a title for display by selecting the first n characters, wherein n is greater than one, and selecting each character by cycling forward and backward (or up/down) through a list of alphanumeric characters as recited in the claims.

Notice of Allowability mailed Aug. 20, 1996, at 1-2.

9. The parent application issued as U.S. Patent 5,629,733 on May 13, 1997.

10. The ‘733 patent notes that in the search mode, “[c]haracters are input using the up/down arrow keys 43A and the ENTER or ‘OK’ key 44. By depressing the up/down keys, the characters in the character boxes cycle through the letters of the alphabet and the digits 0-9.” ‘733 Patent, col. 31, ll. 59-63; Fig. 38F.

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11. Figure 4 shows a remote controller 40 including numeric digit keys 42, direction arrow keys 43A, 43B (labelled “Up,” “Down,” “Left,” “Right”), and ENTER or “OK” key 44. ‘733 Patent, col. 10, ll. 57-64; Fig. 4.

The Reissue Application

12. On May 13, 1999, Appellants filed the present reissue application (09/313,532) with the original patent claims 1-23 and additional claims 24-55. In the reissue declaration, Appellants aver that “U.S. patent 5,629,733 is partly inoperative by reason of said patent claiming less than we had a right to claim in said patent.” Among other things, Appellants note that claim 1 requires “user control means for issuing control commands, including channel-control commands.” According to Appellants, “[d]uring prosecution of the ‘733 patent we failed to appreciate that our invention should have been claimed with apparatus claims that did not include the ‘channel control commands.’ This error is corrected by new apparatus claims 24-38.” Reissue Appl’n filed May 13, 1999, Decl. at 2.

13. Claim 24 of the reissue application was originally filed as follows (underlining omitted):

24. An electronic television programming guide for use in connection with a television receiver for displaying a plurality of television programs from a plurality of sources on a plurality of user-selectable television channels comprising:
a wireless remote control that generates control commands;
a data processor that receives the control commands from the wireless remote control; and

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a video display generator connected to the data processor that displays an alphabetically-arranged visual display of a plurality of television program titles on said television receiver, wherein a user may search for a title to be displayed by selecting n characters with the wireless remote control, where n is greater than one, wherein each of the n characters may be selected with the wireless remote control from a plurality of displayed alphanumeric characters.

Reissue Appl'n filed May 13, 1999, at 39.

14. On May 16, 2007, the Examiner rejected claims 24 and 40 under § 251 as improperly recapturing surrendered subject matter. Non-Final Rej. mailed May 16, 2007, at 2-4.

13. On November 16, 2007, Appellants amended claims 24 and 25 as follows:

24. (Currently amended) An electronic television programming guide for use in connection with a television receiver for displaying a plurality of television programs from a plurality of sources on a plurality of user-selectable television channels comprising:

a wireless remote control, comprising nonalphanumeric keys, that generates control commands;

a data processor that receives the control commands from the wireless remote control; and

a video display generator connected to the data processor that displays an alphabetically-arranged visual display of a plurality of television program titles on said television receiver,

wherein a user may search for a title to be displayed by selecting n characters with the wireless remote control, where n is greater than one, wherein each of the n characters may be selected with the wireless remote control from a plurality of displayed alphanumeric characters by changing from a first character to a second character using the nonalphanumeric keys.

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25. (Currently amended) The electronic television programming guide defined in claim 24 wherein ~~each of the n characters may be selected with the wireless remote control by~~ changing from a first character to a second character comprises cycling through the displayed alphanumeric characters using the nonalphanumeric keys.

Amd't filed Nov. 16, 2007, at 8.

15. On December 10, 2007, the Examiner finally rejected claims 24-55 under § 251 as improperly recapturing surrendered subject matter. Final Rej. mailed Dec. 10, 2007, at 2-3.

16. Appellants appealed the final rejection. Notice of Appeal filed June 9, 2008.

PRINCIPLES OF LAW

Under the recapture rule, Appellants cannot regain subject matter that was surrendered to obtain allowance of the original claims. *North Am. Container, Inc. v. Plastipak Pkg., Inc.*, 415 F.3d 1335, 1349 (Fed. Cir. 2005) (citing *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997)).

The recapture rule is applied as a three-step process to determine:

- (1) whether, and in what respect, the reissue claims are broader in scope than the original patent claims;
- (2) whether the reissue claims relate to the subject matter surrendered in the original prosecution; and
- (3) whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule. *North Am. Container*, 415 F.3d at 1349.

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A limitation “materially narrows” the reissue claims if the narrowing limitation is directed to one or more “overlooked aspects” of the invention. *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482-83 (Fed. Cir. 1998).

The Manual of Patent Examining Procedure (MPEP) provides:

If surrendered subject matter has been entirely eliminated from a claim in the reissue application, or has been in any way broadened in a reissue application claim, then a recapture rejection under 35 U.S.C. § 251 is proper and must be made for that claim.

If, however, the reissue claim(s) are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention), then recapture will not be present.

MPEP § 1412.02(I)(C), 8th ed., Rev. 7, July 2008.

ANALYSIS

To determine whether Appellants impermissibly recaptured surrendered subject matter in reissue claim 24, we consider:

- (1) whether, and in what respect, the reissue claim is broader in scope than the original patent claims;
- (2) whether the reissue claim relates to the subject matter surrendered in the original prosecution; and
- (3) whether the reissue claim was materially narrowed in other respects, so that it was not enlarged thus avoiding recapture. *North Am. Container*, 415 F.3d at 1349.

We address each prong in turn.

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Reissue Claim 24 is Broader Than Issued Claim 1

We find that reissue claim 24 is broader than issued claim 1. First, it is undisputed that the “data processor” and “video display generator” limitations of claim 24 broaden their counterpart limitations in patented claim 1 (i.e., the “data processing means” and “video display generator means” limitations). *See* App. Br. 16; Reply Br. 15; *see also* Ans. 7. These broadened limitations, however, are not germane to the Examiner’s rejection.

But there is a dispute regarding whether the last clause of claim 24 broadens claim 1, and it is this clause that is crucial to resolving this appeal. The Examiner notes that four limitations in patent claim 1 are omitted in reissue claim 24, three of which are in the last clause of claim 1: (1) the selection means (“limitation B” in the Examiner’s parlance); (2) means for causing each character to cycle forward and backward through plural alphanumeric characters (“limitation C”); and (3) means for assigning one of the alphanumeric characters to each of the “n” characters (“limitation D”).
Ans. 6.

While we agree with the Examiner that these limitations are not in claim 24, that omission is not dispositive regarding whether claim 24 broadens claim 1, for the last clause of claim 24 recites a limitation different than claim 1, namely selecting characters from plural displayed characters with a wireless remote control by changing from a first character to a second character using the control’s nonalphanumeric keys. Therefore, the key threshold question before us is whether this limitation in claim 24 broadens its counterpart limitation in claim 1.

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We find that it does. Appellants, however, are correct that issued claim 1 does not explicitly recite selecting characters from plural displayed characters with a wireless remote control by changing from a first character to a second character using the control's nonalphanumeric keys as recited in claim 24. App. Br. 14-16. And we agree with Appellants (*id.*) that this added limitation to reissue claim 24 narrows original claim 1 with respect to the version as it existed before claim 1 was amended during prosecution of the original patent (i.e., claim 1 as originally filed (FF 1)). But we disagree with Appellants that this recitation in claim 24 narrows *issued* claim 1. We reach this conclusion emphasizing the distinction between the functional language of claim 1, namely "means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters," and the language in the last clause of claim 24.

First, claim 1's limitation reciting "means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters" is a means-plus-function limitation that is construed in accordance with 35 U.S.C. § 112, ¶ 6. We therefore interpret this limitation by in light of the corresponding structure described in the Specification and its equivalents. *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

Appellants' patent notes that in the search mode, depressing the up/down keys on a remote controller causes the characters in the character boxes to *cycle through* the letters of the alphabet and the digits 0-9. FF 10-11 (emphasis added). This remote control with its nonalphanumeric keys (i.e., the up/down keys) therefore constitutes the corresponding structure to the recited "means for causing each of said n characters to cycle forward and

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backward through a plurality of alphanumeric characters.” That Appellants emphasized using the remote control’s up/down arrow keys (i.e., nonalphanumeric keys) to achieve this functionality in responding to the Examiner’s rejection during prosecution of the original patent only bolsters this conclusion. *See* FF 4-6.

Although this corresponding structure for claim 1 is equivalent to that recited in claim 24 (i.e., the wireless remote control with nonalphanumeric keys), the function is not. Notably, claim 1 recites that the selection means comprises means for causing the characters to *cycle forward and backward* through plural alphanumeric characters. Claim 24, however, recites selecting characters with the wireless remote control *by changing from a first character to a second character* using the nonalphanumeric keys.

Simply put, changing from a first character to a second character in claim 24 is broader than cycling forward and backward through plural characters in claim 1. That dependent claim 25 further limits claim 24 in calling for changing from a first character to a second character to comprise *cycling through* the displayed alphanumeric characters using the nonalphanumeric keys only bolsters this conclusion.

We therefore find that reissue claim 24 is broader than issued claim 1.

Certain Broader Aspects of Reissue Claim 24 Relate to Surrendered Subject Matter

We also agree with the Examiner (Ans. 6) that certain broadened aspects of claim 24 relate to surrendered subject matter. Notably, in response to a prior art rejection, Appellants added the last clause of claim 1 which includes the selection means comprising means for causing said

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character displays to cycle forward and backward through plural alphanumeric characters. FF 2-3. In connection with this amendment, Appellants argued that providing a means to cycle forward and backward through plural alphanumeric characters enabled selection using the existing keys on remote control devices, namely the up/down arrow keys. FF 4-6.

The clear import of this discussion is that this added feature reciting cycling forward and backward through alphanumeric characters was critical to the invention to solve a problem enabling on-screen searching using remote control devices that was unachievable with full keyboards. *See id.* That the Examiner allowed the application in response to this amendment all but indicates that the Examiner relied on this amendment and accompanying explanation in issuing the application. *See* FF 8 (quoting Examiner's Reasons for Allowance which notes that the prior art does not disclose "selecting each character by *cycling forward and backward* (or up/down) through a list of alphanumeric characters") (emphasis added).⁴

By virtue of this amendment and argument to claim 1 to render the claims allowable, Appellants therefore surrendered the subject matter between the version of original claim 1 (i.e., prior to amendment) and the amended version. *See North Am. Container*, 415 F.3d at 1349. And as noted above, reissue claim 24 broadens this critical surrendering-generating limitation of claim 1 by calling for selecting characters with the wireless remote control *by changing from a first character to a second character* using the nonalphanumeric keys. This broadening therefore relates to the

⁴ *Accord* Ans. 6 ("The limitation of 'providing a user selection means to cycle forward and backward through a plurality of alphanumeric characters' was argued in the parent application to make the application allowable over the cited art in the parent application . . .") (emphasis omitted).

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surrendered subject matter, and essentially broadens patented claim 1 to an intermediate scope (i.e., narrower than original patent claim 1 before amendment, but broader than issued claim 1). *See* FF 1, 3, 7, 13. This broadening therefore constitutes an impermissible recapture of surrendered subject matter.⁵

We disagree with Appellants' contention that the Board's interpretation of *North American Container* is allegedly incorrect. Reply Br. 6-7. We further disagree with Appellants' contention that *North American Container* confirms the standard set forth in *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003) (precedential). The *North American Container* court held that deleting the "generally convex" limitation with respect to the "inner walls" limitation in that case impermissibly recaptured surrendered subject matter since the deleted language was critical in overcoming a prior art reference during prosecution of the original patent. *North Am. Container*, 415 F.3d at 1350. In reaching this decision, however, the court emphasized that it is irrelevant whether the claims as a whole are of "intermediate scope": the recapture rule is applied on a limitation-by-limitation basis. *Id.* (emphasis added).

⁵ *See id.*; *see also* MPEP § 1412.02(I)(C) (noting that impermissible recapture results if the reissue claim omits *or broadens* any limitation that was added/argued during the original prosecution to overcome an art rejection, even if it includes other limitations that narrow the claim in other aspects) (emphasis added); *see also id.* ("If surrendered subject matter has been entirely eliminated from a claim in the reissue application, *or has been in any way broadened in a reissue application claim*, then a recapture rejection under 35 U.S.C. 251 is proper and must be made for that claim.") (emphasis added).

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Eggert conflicts with the Federal Circuit rationale for it was this very “intermediate scope” rationale that formed the basis for the *Eggert* majority’s conclusion that there was no recapture in that case. *See Eggert*, 67 USPQ2d at 1717-18 (holding that broadening the scope of an issued claim via reissue to have a scope between that of the issued claim and the rejected claim does not impermissibly recapture surrendered subject matter under § 251). *See also Ex parte Liebermann*, No. 2007-0012, 2007 WL 5211672 (BPAI 2007) (informative), at *11-12 (noting that *Eggert* is inconsistent with the rationale expressed in *North American Container* and should no longer be followed or apply to USPTO proceedings). *Accord Ex parte Mostafazadeh*, 2009-004238, 2009 WL 5486107 (BPAI 2009) (non-precedential), at *4-7 (explaining underlying reasoning and policy considerations in abrogating *Eggert*).

In view of this conflict, *Eggert* is no longer viable, and, as such, find that Appellants’ broadening via the character selection limitation in claim 24 constitutes an impermissible recapture of surrendered subject matter.

Reissue Claim 24 is not Materially Narrowed in Other Respects to Avoid Recapture

Although we find that Appellants’ broadening relates to surrendered subject matter as noted above, we must nevertheless determine whether claim 24 is materially narrowed in other respects to avoid recapture. *North Am. Container*, 415 F.3d at 1349. A limitation “materially narrows” the reissue claims if the narrowing limitation is directed to one or more “overlooked aspects” of the invention. *Hester*, 142 F.3d at 1482-83.

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Appellants contend that the “wireless remote,” “nonalphanumeric keys,” and “changing” limitations are “overlooked aspects” of the invention since these limitations are directed to a character selection embodiment that was not specifically claimed during original patent prosecution. Reply Br. 4-5, 16.

We disagree. While the specific language “wireless remote,” “nonalphanumeric keys,” and “changing from a first character to a second character” in claim 24 was not explicitly claimed during the original patent prosecution (*see* FF 1, 3, 7), these limitations were, in fact, contemplated by—and indeed correspond to—the language of patent claim 1, particularly in light of its functional language and Appellants’ accompanying arguments in conjunction with amending this claim. *See* FF 3-7. As noted above, the remote control with its nonalphanumeric keys (i.e., the up/down keys) constitutes the corresponding structure under § 112, sixth paragraph to the recited “means for causing each of said n characters to cycle forward and backward through a plurality of alphanumeric characters” in claim 1. *See Donaldson*, 16 F.3d at 1193; *see also* FF 10-11.

As such, these aspects of the invention could hardly have been overlooked during prosecution of the original patent. That Appellants emphasized using the remote control’s up/down arrow keys (i.e., nonalphanumeric keys) to achieve the functionality of claim 1 in responding to the Examiner’s rejection during this prosecution only bolsters this conclusion. *See* FF 4-6.

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And changing from a first character to a second character in claim 24 is merely broader than cycling forward and backward through plural characters in claim 1.⁶ As such, the “changing” limitation in claim 24 pertains to the same embodiment as the “cycling forward and backward” limitation in claim 1, and therefore does not constitute an overlooked aspect of the invention.⁷ That Appellants acknowledge that the recited character selection with the wireless remote control in claim 24 “is performed, for example, *during the cycling of characters (such as is claimed in claims 1 and 12)*” is telling in this regard. App. Br. 10-11 (emphasis added).

We therefore do not find claim 24 to be materially narrowed in other respects to avoid recapture. As such, Appellants’ claim 24 constitutes an impermissible recapture of surrendered subject matter. We reach a similar conclusion regarding (1) independent claim 40 which recites commensurate limitations, and (2) dependent claims 25-27, 29-39, 41-43, and 45-55 not separately argued.

⁶ As noted previously, this broadening is evidenced by dependent claim 25 which further limits claim 24 in calling for changing from a first character to a second character to *comprise cycling through* the displayed alphanumeric characters using the nonalphanumeric keys.

⁷ Notably, original patent claim 23 actually includes language directed to a “user control means including *up/down arrow keys*” and changing the displayed alphanumeric character responsive to depressing an up/down arrow key. Claim 23 (steps (a) and (d)) (emphasis added). These limitations only further evidence our conclusion that the aspects recited in claim 24 directed to the wireless remote control, nonalphanumeric keys, and changing from one character to another were not overlooked during prosecution of the original patent. *Accord* FF 4 (“Users are provided with a *user control means (e.g., a remote control device)* that is used to input a plurality of characters in the title of a program.”) (emphasis added).

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CONCLUSION

The Examiner did not err in rejecting claims 24-27, 29-43, and 45-55 under § 251.

ORDER

The Examiner's decision rejecting claims 24-27, 29-43, and 45-55 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704